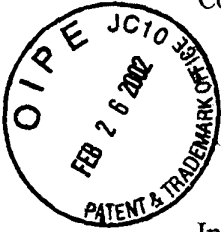


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Janella K. Petrick

Pamela L. Patrick



In re PATENT Application of:)	
Hisato SHINOHARA et al.)	Art Unit: 1762
Serial No. 08/169,127)	
Filed: December 20, 1993)	Examiner: M. Padgett
For: METHOD AND SYSTEM OF LASER)	
PROCESSING)	Date: January 10, 2002

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Sir:

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Please amend the specification as follows:

On page 5, line 13, after the line ending with the word “invention.”, change “Figs. 3(A) to 3(D)” to --Figs. 3(A) to 3(B)--.

The Office Action of August 10, 2001 was received and carefully reviewed. For the reasons advanced in detail below, it is respectfully requested that the action be withdrawn based upon the *Board Decision* of February 23, 2001 and that a new action be issued by the Patent Office that is consistent with that decision.

Initially, Applicants note that the Examiner designates the Official Action of August 10, 2001 as FINAL on page 17 thereof, despite the fact that page 1 of the Official Action does not. In view of the comments provided below with respect to the Examiner's disregard for the decision of February 23, 2001 and the enormous additional expense required by Applicants to respond thereto, Applicants respectfully request that this designation of FINAL be reconsidered and withdrawn and that the new action issued in this case be made NON-FINAL in order to properly prosecute this matter. The undersigned is also more than willing to meet with the Examiner in an interview to resolve this matter after receiving a reasonable Office Action from the Patent Office.

In paragraph 2 of the Office Action, the Examiner questions the Preliminary Amendment of March 11, 1994. Applicants again request amendment to the specification to correct an error relating to Figures 3 (A) and (B) that was addressed by the Petitioner's Office in 1994, since the Preliminary Amendment apparently filed to include the numeral "3". Consideration and entry of this amendment is respectfully requested.

In paragraphs 3-5, the Examiner appears to re-address the rejections that have been appealed in this case for over six (6) years, particularly, the issue of priority support based on a foreign priority claim. This re-hashing of the very same arguments presented on appeal even after receiving the *Board's Decision* of February 23, 2001 is not proper and unfairly jeopardizes Applicants' patent rights in this case. As previously noted, the timing of the assertion of support in the priority document does not somehow effect whether or not it can be used to remove a reference from a rejection. The Examiner continues at length to assert that, because Applicants allegedly proposed a different intended meaning for the claims during a later stage of prosecution, this somehow affects their ability to rely on the priority claim. Applicants do not agree that a "different" interpretation of the claims was given in early stage of prosecution that could prevent priority support and to the extent this argument is understood has no relation to the ultimate question of whether or not Applicants have support for the currently pending claim language in its priority applications, as the Board agreed in its decision.

In response to the first Office Action in this case filed on March 6, 1995, Applicants requested that the reference to Yamazaki et al. ('358) be removed as a reference based on the priority date. Priority was questioned by the Examiner in the Office Action of June 6, 1995 in response to which Applicant clearly provided support in the priority document for the claimed subject matter in the Amendment of August 24, 1995. Applicants also again clearly provided support for the claimed language on appeal in this case in the Appeal Brief of March 6, 1996. This support was provided for the claims prior to the after final amendment of November 7, 1995 that the Examiner refers to in paragraph 3(C) of the Office Action. Furthermore, even if it mattered (which is should not), the appealed claim language does not differ in meaning from the language proposed in the final amendment. As noted during the appeal, just because the Examiner incorrectly interpreted the original claim language (namely, the claim language on appeal) does not provide a basis for denying a priority claim.

The Board clearly agrees with the Applicant in its decision beginning on page 4 thereof. Specifically, the Board notes that the Examiner's explanation does not fully explain where the support "evaporates" in the chain of parent applications and the priority document and requests that this matter be more fully developed. Even more compelling, the Board notes that Applicants explained, "in seemingly persuasive detail," where the claimed subject matter "on appeal" (emphasis added) is supported in their priority document. The Board goes on in even greater detail on page 5 of the decision stating that the disputed 'condensing step' is fully supported by the arguments set forth in the brief and refers to Figures 2(A) -(D) of the priority application. The Board itself even directs the Examiner to pages 6 and 7 of Applicants' specification for further support. As the Board states on page 5, it is the "plain language of the claim" that requires review and analysis. It is not the complex web of arguments presented by the Examiner on appeal and now again, astonishingly, after the Board's decision.

The Board goes on to state that the Examiner has not provided any basis for the lack of support for the claimed language on a claim by claim basis in the chain of prior U.S. applications. As a result, the Examiner's continued reliance on this "intended"

meaning basis for denying consideration of the priority document that was clearly refuted by the Board is very disturbing. It has also created a large amount of additional expense for Applicants in addressing this Office Action that clearly ignores the Board's decision. As a result, Applicants do not believe that it is necessary for it to respond to the rejections set forth in paragraphs 4-7 (or the remaining rejection) since these rejections can be eliminated by properly addressing the priority issue.

Applicants do provide that the inventions of both the instant application and the '358 patent were commonly assigned and the inventors were under an obligation to commonly assign them at the time of conception. This can be further evidenced by the foreign Applicant's name in each of the priority documents for these cases being Semiconductor Energy Laboratory Co., Ltd.

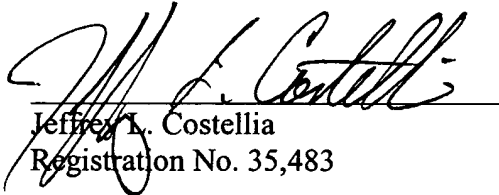
Addressing the remaining new rejections in the Office Action, Applicants respectfully request that the double patenting rejections set forth in paragraph 8 be held for the next action until the priority issues and prior art based rejections are properly addressed in view of the Board's decision, as noted above.

Furthermore, Applicants will address the rejections provided in paragraphs 9-14 when a proper response that adequately takes into account the Board's decision relating to priority is issued by the Patent Office.

*incl. as
new art
rejection -
non response*

In view of the foregoing, it is respectfully requested that the Examiner reconsider this matter in light of the above and the Board's decision and issue a new non-final action that properly addresses the priority issue and, thus, reduces the actual remaining rejections now present in this case.

Respectfully submitted,



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